Atty. Docket No. JP9-2000-0267
(590.083)

REMARKS

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. The Office is respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

Claims 1-22 were pending in the instant application at the time of the outstanding Office Action. Of these claims, Claims 1, 4, 6, 10, 12-13, 15-17, 19-22 are independent claims; the remaining claims are dependent claims. All claims stand rejected 35 U.S.C. § 103(a) in view of Thielens et al. (hereafter "Thielens") in view of Stern et al. (hereafter "Stern") and further in View of WordPerfect Version 5.1 for DOS (hereafter "WordPerfect"). Reconsideration and withdrawal of the present rejections are hereby respectfully requested.

The present invention broadly contemplates methods and systems that generally relate to markup text data error correction support. (Page 1, Line 7) In accordance with the present invention, errors and incorrect conversions can be detected that tend to occur during the re-input of text that is written in a description language for which markups are used to describe data or sentences. (Page 8, Lines 2-4)

As best understood, Thielens appears to be directed to a copy editing apparatus and method. (Col. 1, lines 9-10) Copy editing as used in Thielens appears to refer to the process in which a manuscript copy is edited. As noted therein, such a process has traditionally been performed on paper, and certain conventions have emerged. See Col.

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16, lines 33-36 ("These correspond to the aforementioned markings that the copy editor

normally marks adjacent, for example, the chapter headings, to indicate how they will

print. These markings are conventionally contained with a circle.") Such copy edit

markings may be inserted into an electronic document through the use of a edit tags. See

Col. 17, line 65 through Col. 18, line 20) There is no teaching or suggestion, however,

that these copy edit markings are to be used for error correction.

As best understood, Stern appears to be directed to a system and method for the

automatic preparation and searching of scanned documents, such as microfilm and paper,

in which the probability of errors occurring during the preparation of the scanned

documents is incorporated into the searching process. (Paragraph 1). Such approaches

are typically referred to as "fuzzy searches". As stated in Stern, "[t]he advantage of the

present invention is that is specifically ties the 'fuzziness' of the search to the amount of

error which occurs during the OCR process." (Paragraph 48) Using a fuzzy search to

compensate for the error occurring during the OCR process, Stern states that "the present

invention is able to locate the word 'Henry' even when misspelled as 'Hehry'".

(Paragraph 49) There is, however, no teaching or suggestion of error correction, as in the

present invention.

As best understood, WordPerfect appears to be directed to a spell-checking tool

for use in conjunction with WordPerfect, a word processor that creates textual documents

in DOS. The spell checker uses English language dictionaries unless specified.

International dictionaries may be specified as the dictionary of choice, but modifications

of these dictionaries differ from the modifications that are enabled with English language

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dictionaries. Algorithmic dictionaries may also be set as the dictionary to be used during spell-checking, but these dictionaries may not be modified or changed. Additionally, the spell check does not check words insides of any styles, and only considers words with uppercase or lowercase letters, as well as apostrophes and international letters if specified, as valid words. Parentheses are considered to be invalid characters.

The type of "error detection" as outlined in WordPerfect does not constitute the error detection of the present invention, and in fact is in stark contrast to the error detection of the present invention. In markup language, parentheses and other types of punctuation are frequently used with different meanings and with the same import, if not more, than characters of natural language. In order to detect errors in markup language, these characters must be taken into account, and the syntax of the language must also be taken into account to ensure that errors do not occur with missing parentheses, or within tagged data fields.

The instantly claimed invention requires specifically "defining a tag set to prevent errors or incorrect character conversions that occur frequently during the re-input of text". (Claim 1) Similar language appears in the other independent claims. Preventing errors or incorrect character conversions in a markup description language is simply not taught or suggested by either Thielens, Stern, or WordPerfect.

Moreover, combining the teachings of Thielens, Stern, and WordPerfect would not result in the instantly claimed invention. If these teachings were combined, fuzzy search logic would be incorporated into a manuscript copy editor such that it would be possible to search for natural language terms which may be misspelled and then may be

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subsequently corrected using either user input or automatic correction means. Thus,

following the teachings of Thielens, Stern, and WordPerfect would not result in the

claimed invention of preventing errors or incorrect character conversions in markup

language that occur frequently during the re-input of markup text. Thielens, Stern, and

WordPerfect simply do not teach or disclose this, either alone or in combination.

While the outstanding rejection is based on the combination of Thielens, Stern,

and WordPerfect, nearly twenty years ago, the Court of Appeals for the Federal Circuit

recognized the importance of the individual references in characterizing the holding of *In

re Imperato*, 179 USPQ 730 (C.C.P.A. 1973), as follows:

> The lesson of this case appears to be that prior art referenced in
> combination do not make an invention obvious unless something in the
> prior art references would suggest the advantage to be derived from
> combining their teachings.

Again, in *ACS Hospital Systems, Inc. v. Montifore Hospital*, 221 USPQ 929 (Fed.

Cir. 1984), the Court stated:

> Obviousness cannot be established by combining the teachings of the prior
> art to produce the claimed invention, absent some teaching or suggestion
> supporting the combination. Under section 103, teachings of reference can
> be combined **only** if there is some suggestion or incentive to do so. The
> prior art of record fails to provide any such suggestion or incentive.
> Accordingly, we hold the Court below erred as a matter of law in
> concluding the claimed invention would have been obvious to one of
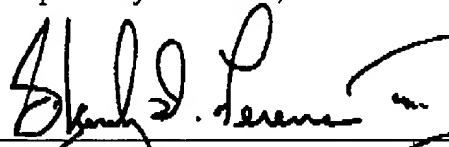> ordinary skill in the art under section 103.

These Federal Circuit teachings are especially cogent here given the combination

of Thielens, Stern and WordPerfect fails to teach or suggest the instantly claimed

invention.

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In view of the foregoing, it is respectfully submitted that Claims 1, 4, 6, 8, 10, 12-13, 15-17, 19-22 are fully distinguishable over the applied art and are thus allowable. By virtue of dependence from Claims 1, 4, 6, 8, 10, 13, and 17, it is thus also submitted that Claims 2-3, 5, 7, 9, 11, 14 and 18 are also allowable at this juncture.

In view of the foregoing, it is respectfully submitted that Claims 1-22 fully distinguish over the applied art and are thus in condition for allowance. Notice to the effect is hereby earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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